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IN THE

Supreme Court of the United States

October Term, 1944. D.

No. 1045

COMPANHIA ANTARCTICA PAULISTA, *Petitioner*

v.

CONWAY P. COE, COMMISSIONER OF PATENTS, *Respondent*.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA AND BRIEF IN SUP-
PORT THEREOF.**

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INDEX.

	Page
Petition	1
Statement of the Case	2
The Question Presented	4
Reasons for Granting the Writ	4
Brief in Support of the Petition	10
Opinions Below	10
Jurisdiction	10
Statement of the Case	10
Specification of Errors	10
The Statute Involved	11
Argument	12
Point I. The decision of the Court below is based upon an interpretation of the words "merely a geographical name or term" of Section 5 of the Trade-mark Act of February 20, 1905 which apparently is in conflict with decisions of this Court bearing thereon	12
Point II. "ANTARCTICA" is used in an arbitrary and fanciful sense as a trade-mark, and no one could have need to employ it in the sense of indicating or describing his goods as coming from that region	15
Point III. The words "merely a geographical name or term" of Section 5 of the Trade-mark registration Act of February 20, 1905 are susceptible of, and have been given, more than one judicial interpretation. The proper interpretation is that which is in harmony with the substantive law of trade-marks and effectuates the intention of Congress to permit registration of all trade-marks valid at common law	17
Conclusion	19

TABLE OF CASES CITED.

	Page
American Steel Foundries v. Robertson, 269 U. S. 371.	4, 12
Brown Chemical Co. v. Meyer, 139 U. S. 540.	7, 15
Columbia Mill Co. v. Alcorn, 150 U. S. 460.	5, 15, 18
In re Canada Dry Ginger Ale, Inc., 24 C. C. P. A. 804, 86 Fed. (2d) 830	9
In re Crew-Levick Company, 1918 C. D. 51, 255 O. G. 160	7
Delaware & Hudson Canal Co. v. Clark, 13 Wall. 311.	6, 13
Elgin National Watch Co. v. Illinois Watch Case Co., 179 U. S. 665	6, 12, 15, 18
In re Fils de R. Picard & Cie, 9 U. S. Pat. Q. 208.	7
In re J. A. Folger & Cie, 4 T. M. Rep. (MS. D).	7
In re Hettrick Mfg. Co., 32 U. S. Pat. Q. 164, 475 O. G. 688	8
In re Kraft-Phenix Cheese Corp., 44 Pat. Q. 218, 511 O. G. 805, 30 T. M. Rep. 216; Affirmed, 28 C. C. P. A. 1153, 120 Fed. (2d) 391	8
Manitou Springs Mineral Water Co. v. Schuller, 239 Fed. Rep. 593	8
In re Plymouth Motor Corporation, 18 C. C. P. A. 838, 46 Fed. (2d) 211	9
In re Russell-Miller Milling Co., 5 T. M. Rep. 114, 116 MS. D. 29	8

STATUTES CITED.

Section 5 of Trade-mark Act of February 20, 1905 (U. S. C., Title 15, Sec. 85).	2, 4, 11, 18
Section 9 of Trade-mark Act of February 20, 1905 (U. S. C., Title 15, Sec. 89)	2
Section 4915 of the Revised Statutes (U. S. C., Title 35, Sec. 63)	2

MISCELLANEOUS.

Restatement of the Law-Torts (1938) Section 720.	17
Report of House Committee on Patents, Report No. 3147, Dec. 19, 1904, H. of R., 58 Cong. 3rd Sess.	5

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DISTRICT OF COLUMBIA.**

PETITION.

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Companhia Antarctica Paulista respectfully prays that a writ of certiorari issue to review the decree of the United States Court of Appeals for the District of Columbia, entered in the above-entitled case on January 15, 1945 (R. p. 15), affirming a decree of the District Court of the United States for the District of Columbia (R. p. 7). A certified transcript of the record in the case, with the necessary

additional copies thereof, has been filed in compliance with Rule 38 of the rules of this Court.

Summary and Short Statement.

The petitioner is a corporation of Brazil, the respondent is Conway P. Coe, Commissioner of Patents, acting in his official capacity. On September 17, 1927 petitioner obtained registration in Brazil of its trade-mark "ANTARCTICA" for soft drinks, syrups and extracts. On July 7, 1941 petitioner filed application Serial No. 445,112 in the United States Patent Office for registration in this country of the same mark for the same goods, stating in its application that the trade-mark sought to be registered had been continuously used and applied to the goods in its business since July 25, 1896.

The respondent, the Commissioner of Patents, acting by the Examiner of Trade-marks, refused registration of "ANTARCTICA" and thereupon petitioner appealed to the Commissioner of Patents, who thereafter on November 18, 1942, affirmed the decision of the Examiner of Trade-marks, and refused registration of petitioner's trade-mark (Commissioner's decision, R. pp. 9-11). The Commissioner cited no registered trade-mark as being in conflict with that sought to be registered by petitioner.

Petitioner then on March 18, 1943 brought this action in the United States District Court for the District of Columbia against the respondent, Commissioner of Patents, under the provisions of Section 9 of the Trade-mark Act of February 20, 1905 (U. S. C., Title 15, Section 89) and under Section 4915 of the Revised Statutes, (U. S. C., Title 35, Section 63). On March 7, 1944 the trial Judge filed an opinion (R. p. 5) holding that the trade-mark "ANTARCTICA" is "merely" a geographical term within the meaning of Section 5 of the Trade-mark Act of February 20, 1905 and therefore is not registerable under the Act; and thereafter, on March 15, 1944, a final judg-

ment dismissing the action was entered (R. p. 7). From the judgment of the United States District Court for the District of Columbia, petitioner appealed to the United States Court of Appeals for the District of Columbia which on January 15, 1945 affirmed the decision of the lower court. (R. p. 15)

The pertinent facts involved are summarized as follows:

- (a) It is common knowledge that "ANTARCTICA" is totally uninhabited, and is a land of perpetual snow and ice incapable of supporting human life. No commerce exists between it and any part of the world.
- (b) "ANTARCTICA" is used by petitioner on its goods in an arbitrary and fanciful sense as a trade-mark, and no one could have need to employ it in the sense of indicating or describing his goods as coming from that region.
- (c) No person upon seeing the mark "ANTARCTICA" affixed to the goods could ever reasonably entertain the belief that it signified the locality where the goods or their ingredients were manufactured or originated.
- (d) "ANTARCTICA" has been used as a trade-mark by petitioner for nearly fifty years and is registered in Brazil. No registered mark has been cited as being in conflict with it, refusal of registration being based solely upon the ground that the mark "ANTARCTIA" is "*merely* a geographical name or term" within the meaning of Section 5 of the Trade-mark registration Act of February 20, 1905 (U. S. C., title 15, sec. 85).

Question Presented.

The sole question is:

What is the proper interpretation of that portion of Section 5 of the Trade-mark registration Act of February 20, 1905 (U. S. C., title 15, sec. 85), which reads:

"Provided, That no mark . . . merely a geographical name or term, shall be registered under the terms of this Act."

Is the expression "merely a geographical name or term" properly to be interpreted in harmony with the substantive law of trade-marks and in the sense it is used in decisions of this Court expounding that law prior to the passage of the Act, so as thus to permit registration of geographical names which are used in an arbitrary and fanciful sense and thereby perform the office of valid trade-marks at common law by pointing out distinctively the personal origin or ownership of the goods;

Or are all geographical names or terms precluded from registration by this provision of the Act, irrespective of their validity or invalidity as trade-marks at common law?

Reasons for Granting the Writ.

1. The Court of Appeals below has decided an important question of Federal law which has not been, but should be, settled by this Court, namely, the question as to the proper interpretation of the words "merely a geographical name or term" occurring in Section 5 of the Trade-mark Registration Act of February 20, 1905 (U. S. C., title 15, sec. 85).

2. The Court of Appeals below has decided the question here involved in a way probably in conflict with the intent and language of the decision of this Court in *American Steel Foundries v. Robertson*, 269 U. S. 371, wherein, setting forth the manner in which the said Act should be construed, it is stated, pp. 379, 381:

"The answer to this question (as to the meaning of the words "merely the name of a corporation") will be simplified if we approach it by first considering certain *principles of the substantive law of trade-marks and unfair competition, in the light of which the legislation under review must be examined. . . .*

"These principles, it must be assumed, were in mind when Congress came to enact the registration statute. And, since that body has been given no power to legislate upon the substantive law of trademarks, it reasonably may be assumed, also, that, to the extent the contrary does not appear from the statute, *the intention was to allow the registration of such marks as that law, and the general law of unfair competition of which it is a part, recognized as legitimate.* The House Committee on Patents, in reporting the bill which upon enactment became the registration statute in question, said: 'Section 5 of the proposed bill we believe *will permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a trade-mark and become the exclusive property of the party using the same as his trademark.*' Report No. 3147, Dec. 19, 1904, H. of R., 58th Cong., 3d Sess.

"The provision, therefore, that no mark consisting merely in the name of a corporation shall be registered, *is to be construed in harmony with those established principles in respect of the appropriation of corporate names to which we have referred.*" (Italics added)

3. The Court of Appeals below has decided the question here involved in a way probably in conflict with decisions of this Court explanatory of the meaning in the substantive law of trade-marks of the expression "*merely a geographical name or term,*" as set forth in *Columbia Mill Co. v. Alcorn*, 150 U. S. 460, wherein it is stated, p. 463:

"The appellant was no more entitled to the exclusive use of the word 'Columbia' as a trade-mark than he would have been to the use of the word 'America', or 'United States', or 'Minnesota', or 'Minneapolis'. These *merely* geographical names cannot be appropriated and made the subject of exclusive property.

They do not in and of themselves, indicate anything in the nature of origin, manufacture, or ownership; and in the present case the word 'Columbia' gives no information on the subject of origin, production or ownership." (Italics added)

And in *Elgin National Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, wherein it is stated, p. 673:

"And the general rule is thoroughly established that words that do not in and of themselves indicate anything in the nature of origin, manufacture, or ownership, but are *merely descriptive of the place* where an article is *manufactured or produced*, cannot be monopolized as a trade-mark." (Italics added).

And wherein it is also stated, p. 677:

"And since, while the secondary signification attributed to its use of the word ("Elgin") might entitle appellant to relief, the fact that, *primarily, it simply described the place of manufacture*, and that appellees had the right to use it *in that sense*, though not the right to use it without explanation or qualification, if such use would be an instrument of fraud, we are of opinion that the general rule applied, and that *this geographical name could not be employed as a trade-mark*, and its exclusive use rested in appellant, and that it was *not* properly entitled to be registered as such." (Italics added)

And in *Delaware & Hudson Canal Company v. Clark*, 13 Wall. 311, wherein it is stated, p. 324:

"And it is obvious that *the same reasons* which forbid the exclusive appropriation of generic names or of those *merely descriptive of the article manufactured and which can be employed with truth by other manufacturers*, apply with equal force to the appropriation of *geographical names*, designating districts of country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. *They point only at the place of production, and not to the producer. . . .*" (Italics added)

And wherein it is also stated, p. 327:

“It must be considered as sound doctrine that no one can apply the name of a district of country to a well known article of commerce, and obtain thereby such an exclusive right to the application as to prevent others *inhabiting* the district or dealing in similar articles *coming from the district* from truthfully using the same designation.” (Italics added)

And in *Brown Chemical Co. v. Meyer*, 139 U. S. 540, wherein it is stated, p. 542:

“The general proposition is well established that words which are *merely descriptive* of the character, qualities or composition of an article, or of the *place where it is manufactured or produced* cannot be monopolized as a trade-mark.” (Italics added)

4. The Court of Appeals below has decided an important question of Federal law upon which there is considerable diversity and unsettlement of judicial opinion and which should be definitely settled by this Court in order that this registration Act may hereafter be administered with uniformity and certainty by the Commissioner of Patents and the courts.

(a) The following cases decided by the Commissioner of Patents hold that geographical terms used in an arbitrary and fanciful sense, and obviously not signifying to any ordinary person the place where the goods were produced, are *not* “merely geographical names or terms” within the meaning of the trade-mark registration statute and, therefore, are registrable thereunder:

In re J. A. Folger & Co., 4 T. M. Rep. 41 (S. D.) granting registration to “Shasta” for coffee;

In re Crew Levick Company, 1918 C. D. 51, 255 O. G. 161, granting registration to “Cashmere” for a wool lubricating oil;

In re Fils DeR. Picard & Cie, 9 U. S. Pat. Q. 208, granting registration to “Everest” for watches:

In re Russell-Miller Milling Co., 5 T. M. Rep. 114, 116 MS D. 29, granting registration to "Occident" for bread.

(b) The United States Circuit Court of Appeals for the Eighth Circuit has held that a "mark" which signifies to the public the manufacturer or producer of the goods to which it is affixed is not "merely a geographical name or term" and may be registered under the Act here involved:

Manitou Springs Mineral Water Co. v. Schueler, 239 Fed. 593, 601 (8 C. C. A.)

(c) The instant case and the following recent cases decided by the Commissioner of Patents hold that *all* words which are names of places or localities are, irrespective of any other consideration and without exception, forbidden registration by the terms of the Act here involved:

In re Hettrick M. Mfg. Co., 32 Pat. Q. 164, 475, O. G. 688, where, in refusing registration of "Edge-wood," it was held that the language of the statute "leaves no room for exception, but forbids registration of *all* geographical terms, including those with alternative meanings, one of which may be non-geographical."

In re Kraft-Phenix Cheese Corp., 44 U. S. Pat. Q. 218; 511 O. G. 805; 30 T. M. Rep. 216, where, in refusing registration of "Chantelle", it was said "If a word (geographical name) has no other meaning, it is necessarily 'merely' geographical, regardless of the extent to which it is known." (Affirmed, U. S. Court of Customs and Pat Apps., 28 C. C. P. A. 1153, 120, Fed. 2d 391)

(c) The United States Court of Customs and Patent Appeals, which has appellate jurisdiction in the matter of registration of trade-marks, has interpreted the words "merely a geographical name or term" of Section 5 of the Trade-mark Act of February 20, 1905 differently at different times:

In the case of *In re Plymouth Motor Corporation*, 18 C. C. P. A. 838, 46 Fed. (2d) 211, it is held that if a geographical term has a secondary meaning it is not merely geographical within the meaning of the trade-mark Act of February 20, 1905 and is therefore registerable. In this case the expression "secondary meaning" was not used in its technical trade-mark sense, but simply in the sense of "another meaning."

In the case of *In re Canada Dry Ginger Ale, Inc.*, 24 C. C. P. A. 804, 86 Fed. (2d) 830, the same court has subsequently reached a different conclusion as to the interpretation of the words "merely a geographical name or term" occurring in the Act and has overruled its former holding as to their meaning.

Wherefore your petitioner prays that a writ of certiorari issue to the United States Court of Appeals for the District of Columbia, commanding said Court to certify and send to this Court, on a day to be designated, a full and complete transcript of the record of all proceedings of the Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court; and that the judgment of the Court of Appeals denying that petitioner is entitled to register its trade-mark under the provisions of the trade-mark Act of February 20, 1905 be reversed; and that the petitioner be granted such other and further relief as may seem proper.

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BRIEF IN SUPPORT OF PETITION

Opinions Below.

The opinion (not reported) of the District Court of the United States for the District of Columbia, on the question here involved, appears at page 5 of the record; and the opinion of the United States Court of Appeals for the District of Columbia (not reported) appears at page 14 of the record.

Jurisdiction.

The decree below was entered on January 15, 1945 (R. p. 15). The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925; U. S. C. Title 28, Section 347 (a).

Statement of the Case.

The principal facts pertinent to the single question are sufficiently stated in the Petition, *ante*, pages 2-3.

Specification of Errors.

(1) The United States Court of Appeals for the District of Columbia erred in finding and holding that a geographical name used in an arbitrary and fanciful sense as a mark indicating the producer or originator of the goods, and having no significance as to any place where the goods are or could be produced, is "merely a geographical name or term" within the meaning of Section 5 of the Trade-mark registration Act of February 20, 1905 and that it therefore is not registerable.

(2) The said Court erred in affirming and in not reversing the decree of the District Court holding the mark "ANTARCTICA" to be "merely a geographical name or term" within the meaning of the Trade-mark Act of February 20, 1905 and dismissing the complaint.

Summary of Argument.

The points of argument follow the reasons relied upon for the allowance of the writ and are conveniently summarized in the petition under "Reasons for Granting the Writ", *ante*, pp. 4-8.

Statute Involved.

The statute involved is Section 5 of the Trade-mark Act of February 20, 1905, U. S. C., title 15, sec. 85, the relevant part of which is as follows:

"That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark * * *

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, * * *: *Provided, That no mark* which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or *merely a geographical name or term*, shall be registered under the terms of this Act: * * *." (Italics added)

ARGUMENT.**POINT I.**

The decision of the Court below is based upon an interpretation of the words "merely a geographical name or term" of Section 5 of the Trade-mark Act of February 20, 1905 which apparently is in conflict with decisions of this Court bearing thereon.

This Court has declared, in *American Steel Foundries v. Robertson*, 269 U. S. 371, 381, that it must be assumed that, when the registration statute of February 20, 1905 was enacted, Congress must have had in mind the principles of the substantive law of trade-marks; that the provisions of the Act are to be construed in the light of and in harmony with the established principles of that substantive law; and that in passing the Act, it was the intention of Congress to permit the registration of all marks which could, under the common law as expounded by the courts, be the subject of a valid trade-mark.

As this Court has repeatedly pointed out, the office of a trade-mark is to distinguish, to set apart, the goods of a particular trader from those of other traders. If a mark, whatever be its character, performs that office *at the time of its adoption*, it is a true trade-mark, valid at common law. There is no doubt of the rule. As to what may be a trade-mark, this Court has said, in *Elgin National Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665,

"It (a trade-mark) may consist in *any* symbol or in *any* form of words, but as *its office is to point out distinctively the origin or ownership of the articles to which it is affixed*, it follows that no sign or form of words can be appropriated as a valid trade-mark which, from the nature of the fact conveyed by its primary meaning, others may employ with equal truth and with equal right for the same purpose.

"And the general rule is thoroughly established that words that do not in and of themselves indicate anything in the nature of origin, manufacture, or owner-

ship, but are *merely descriptive of the place where an article is manufactured or produced*, cannot be monopolized as a trade-mark." (Italics added).

This Court, in *Delaware & Hudson Canal Co. v. Clark*, 13 Wall. 311, has likewise stated that:

"The office of a trade-mark is to point out distinctively the origin or ownership of the article to which it is affixed; or, in other words, *to give notice who was the producer*. This may, in many cases, be done by a name, a mark, or a device well known, but not previously applied to the same article. . . .

"Hence the trade-mark must either by itself, or by association, *point distinctively to the origin or ownership of the article to which it is applied*. The reason of this is that unless it does, neither can he who first adopted it be injured by any appropriation or limitation of it by others, nor can the public be deceived. The first appropriator of a name or device *pointing to his ownership*, or which by being associated with articles of trade, has acquired an understood reference to the originator, or manufacturer of the articles, is injured whenever another adopts the same name or device for similar articles, because such adoption is in effect representing falsely that the productions of the latter are those of the former. . . . The trade-mark must, therefore, be distinctive in its original signification, pointing to the origin of the article, or it must have become such by association. And there are two rules that are not to be overlooked. No one can claim protection for the exclusive use of a trade-mark or trade name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected, for competition would be destroyed. Nor can a generic name, or a name merely descriptive of an article of trade, of its qualities, ingredients, or characteristics, be employed as a trade-mark and the exclusive use of it be entitled to legal protection. As we have said in the well-considered case of *Amoskeag Mfg. Co. v. Spear*, *supra* 'the owner of an original trade-mark has an undoubted right to be protected in the exclusive use of all the marks, forms,

or symbols that were *appropriated as designating the true origin or ownership of the article or fabric to which they are affixed*; but he has no right to the exclusive use of any words, letters, figures or symbols which have *no relation to the origin or ownership of the goods*, but are only meant to indicate their names or quality. He has no right to appropriate a sign or symbol *which from the nature of the fact it is used to signify, others may employ with equal truth* and, therefore, have an equal right to employ for the same purpose.' . . .

"And it is obvious that *the same reasons which forbid the exclusive appropriation of generic names or of those merely descriptive of the article manufactured, apply with equal force to the appropriation of geographical names designating districts of country. Their nature is such that they cannot point to the origin (personal origin) or ownership of the articles of trade to which they may be applied. They point only at the place of production, not to the producer, and could they be appropriated exclusively, the appropriation would result in mischievous monopolies.*" (Italics added)

These frequently approved decisions of this Court are clear and satisfactory expositions of the philosophy of the substantive law of trade-marks. From them it is evident that the gist of a trade-mark is its function of signifying to the public mind that the goods to which the mark is affixed are the product of a particular manufacturer or originator. From them it is evident also that, *at common law, a geographical name is not precluded from being a trade-mark simply because it is geographical, but, as is true of all names or marks generally, it fails of being a trade-mark if it does not signify to the public mind the manufacturer or originator of the goods to which it is affixed.* That this is the correct rule of the common law is unquestionable. Whether a term associated with the particular goods to which it is affixed as a "mark" is, in the sense of the common law, merely geographical or not must depend in the last analysis upon whether the public might suppose that the term signified a *place* where the goods originated,

and this because the only reason Congress had for prohibiting the registration of geographical names was that, as pointed out by this Court in the cases above quoted from, it would interfere with the rights of others who had an equal right to use the term to indicate that their goods came from that place.

Where a geographical name or term is used in an arbitrary and fanciful sense *not signifying* to purchasers the *place* from which the goods so marked came, *but indicating instead the particular manufacturer or producer of the goods*, it is a legitimate trade-mark, for it is then not "merely geographical", *not* "merely descriptive . . . of the *place* where it is manufactured or produced", *not* "merely descriptive of the *place* where an article is manufactured or produced", and *not* "merely a geographical name" within the intent and meaning of those phrases as they are used in the *Brown Chemical Co.*, *Columbia Mill Co.* and *Elgin* cases, *supra*. A name or term may have geographical significance when considered simply as a mere word alone, but if, as a "*mark*" *affixed to an article of trade*, it *signifies to the mind of the public the particular manufacturer or originator of the article*, it is, properly speaking, *not* "merely geographical", nor, indeed, "geographical" at all in the sense of the substantive law of trade-marks.

POINT II.

"Antarctica" is used in an arbitrary and fanciful sense as a trade-mark, and no one could have need to employ it in the sense of indicating or describing his goods as coming from that region.

"ANTARCTICA" is a geographical name. But as a "*mark*" affixed to respondent's goods (soft drinks, extracts, syrups) it is purely fanciful. It was arbitrarily selected to indicate to the public the manufacturer or producer of the goods. The public could not reasonably understand it to have any other signification in relation to the goods to which it is affixed.

It could not reasonably be regarded by purchasers as signifying the *place* of manufacture or *place* of origin of the goods or their ingredients, for it is common knowledge that the region called "Antaretica" is totally uninhabited and is a land of perpetual snow and ice incapable of supporting human life (National Geographic Magazine, August 1920, page 127 et seq.). It is manifestly impossible for any one to engage in business in "Antaretica" or for commerce to exist between it and any part of the world. No one could have occasion to employ "Antaretia" in his business in the sense of indicating or describing his goods as coming from that region. Petitioner's arbitrary and fanciful use of "Antaretica" as a trade-mark therefore does not interfere with or embarrass any public or private right.

No person, seeing "ANTARCTICA" affixed to the goods, would ever reasonably entertain a belief that it signified the *locality* where the goods or their ingredients were manufactured or originated, any more than he would believe that the word "Brobdingnag," the land of the giants of Swifts' Gulliver's Travels, if affixed to an article of trade, signified that the article was produced there, or that the name "North Pole" affixed to a lead pencil was intended to indicate the *place* of production of the pencil. Recognizing the practical and commercial impossibility of manufacturing any goods in "Antaretica", it would be at once apparent to the purchasing public that the mark "ANTARCTICA" was used on the goods in purely arbitrary and fanciful sense and, to the exclusion of all else, was affixed to the goods for the purpose of identifying them as the product of a particular manufacturer or producer. No other deduction would be reasonable or sensible. Any other deduction would be absurd and against common sense.

In the sense of the rule of the substantive law of trade-marks respecting the appropriation of geographical names used in an arbitrary and fanciful sense as "marks" for goods, "ANTARCTICA" is not "merely a geographical name", but is a valid trade-mark at common law.

The rule that geographical names or terms which are arbitrarily and fancifully used to identify the producer of the goods are valid trade-marks at common law is expressed in the "Restatement of Law—Torts", Section 720, as follows:

"A geographical name cannot be a trade-mark for goods unless (a) the use of the name in connection with such goods is not likely to be understood by purchasers as representing that the goods or their constituent materials were produced or processed in the place designated by the name or that they are of the same distinctive kind or quality as the goods produced, processed or used in that place, * * *."

POINT III.

The words "merely a geographical name or term" of Section 5 of the Trade-mark registration Act of February 20, 1905 are susceptible of, and have been given, more than one judicial interpretation. The proper interpretation is that which is in harmony with the substantive law of trade-marks and effectuates the intention of Congress to permit registration of all trade-marks valid at common law.

There has been a diversity of judicial opinion of Courts and various Commissioners of Patents (*ante*, pp. 7-9) as to the proper interpretation of the provision of Section 5 of the Trade-mark Act of February 20, 1905 that "no mark . . . merely a geographical name or term, shall be registered under the terms of this Act."

It has been held in some decisions (*ante*, pp. 8-9) that by the use of the words "merely a geographical name or term" the Act precludes registration of *all* geographical names or terms whatsoever, irrespective of their validity or invalidity as trade-marks at common law. Other decisions (*ante*, pp. 7-8) have held that the provision of the Act denying registration to marks which are "merely a geographical name or term" is *not* to be understood as

precluding registration of *all* geographical names or terms, but is properly to be interpreted as permitting registration of those geographical names or terms which are used in an arbitrary and fanciful sense and which, as "marks" affixed to the goods, are not "*merely*" geographical since they have no geographical signification in the public mind as to a place where the goods are or could be manufactured or produced.

The first of these two interpretations—the one currently being applied by the Commissioner of Patents, the Court of Appeals below and the Court of Customs and Patent Appeals—is not in harmony with the substantive law of trade-marks and is contrary to the intention of Congress in passing this trade-mark registration statute. It probably grows out of the failure by courts and Commissioners of Patents to correctly distinguish and give effect to the difference between the signification of a word to the public when, on the one hand, it is used as a "*mark*" affixed to goods, and when, on the other hand, it is used *simply as a word* of ordinary speech. This distinction is fundamentally inherent in the substantive law of trade-marks, as appears from the decisions of this Court in the *Columbia Mill case* and in the *Elgin case, supra* (*ante*, pp. 5-6). It is implicit in the statute itself, dealing, as it does, with the registration of trade-marks. Moreover, Section 5 of the Act, which is the section here involved, expressly recites that it concerns the registration of *marks* "by which the goods of the owner of the mark may be distinguished from other goods of the same class," i. e., trade-marks.

The word "mark" occurring in the portion of Section 5 of the Act reading:

"*Provided*, That no mark . . . merely a geographical name or term, shall be registered under the terms of this Act",

should obviously be understood here in the same sense in which it is used in the substantive law of trade-marks and as it is used elsewhere in the Act, namely, a "*mark*" af-

fixed to the goods. And the *meaning* of a "mark", in the sense of the substantive law of trade-marks, is its meaning to the public when *associated with the goods*. Its meaning to the public when it is *not* affixed to the goods, but as it is used in common speech, is *not* its meaning as a "mark" in the sense of the law of trade-marks. For example, the word "Anchor" affixed as a "mark" to a tin of tobacco would obviously signify to the public nothing more than that the tobacco within the tin so marked was the product of a particular manufacturer or processor. It has an entirely different meaning when it is not used as a "mark" affixed to goods. The same is true as to the meaning in the sense of the substantive law of trade-marks of any "mark" *affixed to the goods*. If, therefore, a geographical name or term when seen as a "mark" *affixed to goods* primarily means to the public a particular producer or manufacturer of the goods, that "mark" is not "merely" a geographical name or term in the sense of the law of trade-marks, since, as *affixed to the goods*, its signification to the public is *not* that it points to a *place* where the goods are or may be produced.

The diversity of judicial opinion by Courts and Commissioners of Patents as to the proper interpretation of the words "no mark . . . merely a geographical name or term" apparently arises out of the failure, in some instances, to recognize that, in the light of the substantive law of trade-marks as set forth in decisions of this Court, a "mark" (trade-mark) is not "*merely* a geographical name or term", if its significance to the public as a "mark" is something other than geographical.

CONCLUSION.

The granting of a writ of certiorari in this case is peculiarly appropriate. The question is one never decided by this Court and upon which considerable diversity of judicial opinion exists. The uncertainty as to the proper interpretation of the proviso of Section 5 of the Trade-

mark Act of February 20, 1905 that "no mark . . . merely a geographical name or term shall be registered under the terms of this Act", will be removed by a decision of this Court in this case, and the Commissioner of Patents, the United States Court of Customs and Patent Appeals and the United States Court of Appeals for the District of Columbia will thenceforth be enabled to apply this portion of Section 5 to the statute correctly and with uniformity.

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(14)

No. 1045

In the Supreme Court of the United States

OCTOBER TERM, 1945

COMPANHIA ANTONIO DE PAULISTA, PETITIONER

CONTRA THE COMMISSIONERS OF CUSTOMS

ON PETITION FOR A WRIT OF HABEAS CORPUS TO REMOVE
STATES COURT OF APPEALS CASE NO. 1045 TO
COURT OF APPEALS

WRIT FOR THE PETITIONER TO BE GRANTED

INDEX

	Page
Opinions below	1
Jurisdiction	1
Question presented	2
Statute involved	2
Statement	3
Argument	4
Conclusion	8

CITATIONS

Cases:

<i>American Steel Foundries v. Robertson</i> , 269 U. S. 372.....	5
<i>Black Band Consol. Coal Co. v. Glenn Coal Co.</i> , 20 F. 2d 284.....	5
<i>Columbia Mill Co. v. Alcorn</i> , 150 U. S. 460.....	6
<i>Elgin Nat. Watch Co. v. Elgin Razor Corp.</i> , 25 F. Supp. 886.....	6
<i>Elgin National Watch Co. v. Illinois Watch Co.</i> , 179 U. S. 665.....	6
<i>Illinois Watch Case Co. v. Shulton</i> , 111 F. 2d 298.....	6
<i>In Re California Perfume Co.</i> , 56 F. 2d 885.....	5
<i>In Re Canada Dry Ginger Ale, Inc.</i> , 86 F. 2d 830.....	5, 7
<i>In Re Crescent Typewriter Supply Co.</i> , 30 App. D. C. 324.....	4, 7
<i>In Re Deutz & Ortenberg, Inc.</i> , 296 Fed. 1012.....	5
<i>In Re Hopkins</i> , 29 App. D. C. 118.....	5, 7
<i>In Re Kraft-Phenix Cheese Corp.</i> , 120 F. 2d 391.....	5, 7
<i>In Re Plymouth Motor Corp.</i> , 46 F. 2d 211.....	7
<i>Kentucky D. & W. Co. v. Old Lexington C. D. Co.</i> , 31 App. D. C. 223.....	5
<i>Kraft Cheese Co. v. Coe</i> , 146 F. 2d 313 petition for certiorari filed March 27, 1945, No. 1084.....	5, 7
<i>La Republique Francaise v. Saratoga Vichy Springs Co.</i> , 107 Fed. 459.....	6
<i>Manitou Springs Mineral Water Co. v. Schueler</i> , 239 Fed. 593.....	6
<i>Montevallo Mining Co. v. Little Gem Coal Co. et al.</i> , 57 App. D. C. 100.....	5

Statutes:

Revised Statutes, sec. 4915 (35 U. S. C. 63).....	3
Trade-Mark Act of February 20, 1905, sec. 5, 33 Stat. 725, as amended, 15 U. S. C. 85.....	2, 4, 6

Miscellaneous:

Webster's New International Dictionary (Unabridged, Second Edition, 1939).....	4
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In the Supreme Court of the United States

OCTOBER TERM, 1944

No. 1045

COMPANHIA ANTARCTICA PAULISTA, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE DISTRICT OF
COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the District Court of the United States for the District of Columbia (R. 5-6) is not officially reported. The opinion of the Court of Appeals for the District of Columbia (R. 14) is reported in 146 F. 2d 669.

JURISDICTION

The judgment of the Court of Appeals was entered on January 15, 1945 (R. 15). The petition for a writ of certiorari was filed on March 16, 1945. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether the mark "Antaretica", as applied to beverages, syrups, and extracts, is entitled to registration under the Trade-Mark Act of February 20, 1905, Section 5 of which prohibits the registration of a mark which is "merely a geographical name or term."

STATUTE INVOLVED

Section 5 of the Trade-Mark Act of February 20, 1905, 33 Stat. 725, as amended, 15 U. S. C. 85, provides, in part:

No mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

* * * *

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, * * *: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: * * *

STATEMENT

On July 7, 1941, petitioner, a company "existing under the laws of Brazil" and having its principal place of business there, filed its application with the United States Patent Office to register the mark "Antarctica", under the Trade-Mark Act of February 20, 1905, as a trade-mark for natural mineral waters, nonalcoholic maltless beverages, and syrups and extracts for making soft drinks (R. 2-3.) The mark had previously been registered by the petitioner in Brazil (R. 3). The Examiner of Trade-Marks refused to register the mark "'Antarctica' on the ground that the term is merely geographical" (R. 8-9) within the meaning of the proviso of Section 5 of the Act of February 20, 1905, and this decision was affirmed on appeal by the First Assistant Commissioner of Patents (R. 9-11).

Under Section 4915 of the Revised Statutes (35 U. S. C. 63), petitioner thereupon brought suit against the Commissioner of Patents in the United States District Court for the District of Columbia, to compel the Commissioner to allow the mark "Antarctica" registration under the 1905 Act (R. 2-4). That court dismissed the petitioner's complaint (R. 5-7). On appeal, the United States Court of Appeals for the District of Columbia affirmed the dismissal of the complaint, *per curiam*, rejecting petitioner's argument that the use of "Antarctica" as applied to its

product was fanciful and not "merely geographical" within the terms of the proviso of Section 5 of the Trade-Mark Act of 1905 (R. 14).

ARGUMENT

1. Section 5 of the Trade-Mark Act of 1905, under which petitioner sought registration of the word "Antarctica", provides that no mark shall be registered which consists in "merely a geographical name or term." Conceding that "'Antarctica' is a geographical name,"¹ petitioner argues that the mark is "purely fanciful" (Br. 15), and not "merely * * * geographical" and thus without the proviso of Section 5. But the court below refused to "read such an exception into the plain language of the act" (R. 14).

The courts have consistently held that Section 5 of the Trade-Mark Act, forbidding the registration of "merely a geographical name or term," is "broad enough to prohibit the use of any word that has an exclusive geographical significance, or that would suggest any particular geographical location" including "use of a name that applies to a particular section of the globe." *In Re Crescent Typewriter Supply Co.*, 30 App. D. C. 324, 326-327 (the word "Orient" as applied to ink ribbons

¹ Webster's New International Dictionary (Unabridged, Second Edition, 1939) defines "Antarctica" as "Matters connected with the antarctic." "Antarctic" is defined as "Opposite to the north, or arctic, pole; relating to the south pole or to the region near it."

and carbon paper); see also *In Re Hopkins*, 29 App. D. C. 118 ("Oriental" as applied to a skin cream); *Kentucky D. & W. Co. v. Old Lexington C. D. Co.*, 31 App. D. C. 223 ("Old Lexington Club" as applied to whiskey); *Montevallo Mining Co. v. Little Gem Coal Co. et al.*, 57 App. D. C. 100 ("Montevallo" as applied to coal); *In Re Deutz & Ortenberg, Inc.*, 296 Fed. 1012 (App. D. C.) ("House of France" as applied to clothing); *Black Band Consol. Coal Co. v. Glenn Coal Co.*, 20 F. 2d 284 (App. D. C.) ("Black Band" as applied to coal); *In Re California Perfume Co.*, 56 F. 2d 885 (C. C. P. A.) ("Avon" as applied to toothbrushes); *In Re Canada Dry Ginger Ale, Inc.*, 86 F. 2d 830 (C. C. P. A.) ("Canada Dry" as applied to a beverage); *In Re Kraft-Phenix Cheese Corporation*, 120 F. 2d 391 (C. C. P. A.) ("Chantelle" as applied to cheese); *Kraft Cheese Co. v. Coe*, 146 F. 2d 313 (App. D. C.) petition for certiorari filed March 27, 1945, No. 1084 ("Old English" as applied to cheese).²

² *American Steel Foundries v. Robertson*, 269 U. S. 372, on which petitioner heavily relies (Pet. & Br. 4-5, 12), did not involve a geographical name. Nor does the decision in that case stand for the proposition that all marks, susceptible of appropriation at common law, are registrable under the 1905 Act. This Court specifically stated that the common law rules were assumed to be adopted to "the extent that the contrary does not appear from the statute" (269 U. S. at 381). Merely geographical names or terms are denied registration by the statute, and here the court below, the district court, and the Commissioner of Patents all found that the name "Antartica" was a merely geographical name or term.

2. In stating that the mark "Antarctica" "was arbitrarily selected to indicate to the public the manufacturer or producer of the goods" (Br. 15), petitioner may be contending that its mark is entitled to registration because it will acquire a "secondary meaning". But there is nothing in the record to show that petitioner's products have been marketed in this country under the mark "Antarctica". Even before the enactment of the Trade-Mark Act of 1905, it was well recognized that "a mere geographical name" does not acquire a secondary meaning "without attending facts which have caused the name to become significant of a particular manufacture and to identify the manufacture as the product of a particular person". *La République Française v. Saratoga Vichy Springs Co.*, 107 Fed. 459, 461 (C. C. A. 2); see also *Columbia Mill Co. v. Alcorn*, 150 U. S. 460; *Elgin National Watch Co. v. Illinois Watch Co.*, 179 U. S. 665.

Moreover, the words "arbitrary, fanciful, or secondary meaning" do not appear in the proviso of Section 5.³ Thus with but a single exception,⁴ the courts have consistently recognized that,

³ The only "merely * * * geographical" marks presumed to have secondary significance under the 1905 Act are those registrable under the ten-year provision of Section 5—i. e., those which were used exclusively and in good faith for ten years before the passage of the 1905 Act. See *Illinois Watch Case Co. v. Shulton*, 111 F. 2d 298, 299 (C. C. P. A.);

irrespective of any arbitrary, fanciful, or secondary meaning, a mark is nevertheless not registrable under the 1905 Act if, by its terms, it is "merely * * * geographical". *In re Hopkins*, *In re Crescent Typewriter Supply Co.*, *In re Canada Dry Ginger Ale*, *In re Kraft Phenix Corporation*, *Kraft Cheese Co. v. Coc*, all *supra*.

see also *Manitou Springs Mineral Water Co. v. Schueler*, 239 Fed. 593, 602 (C. C. A. 8); *Elgin Nat. Watch Co. v. Elgin Razor Corp.*, 25 F. Supp. 886, 887 (N. D. Ill.). Petitioner did not seek registration of the mark "Antarctica" under the ten-year provision.

⁴ In the case of *In re Plymouth Motor Corporation*, 46 F. 2d 211 (C. C. P. A.), a mark comprising a picture of a sailing vessel at sea, together with the words "Chrysler Plymouth" was held by the Court of Customs and Patent Appeals to have "a meaning other than one merely geographic" and to be registrable under the 1905 Act (p. 213). But the doctrine of the *Plymouth* case was specifically rejected and "considered as overruled" by the same court in *In re Canada Dry Ginger Ale*, 86 F. 2d 830, 833. Since the decision in the *Canada Dry* case in 1936, it has been the policy of the Patent Office to reject all trade marks involving geographical terms, irrespective of a "secondary meaning". The alleged confusion in earlier Patent Office rulings, to which petitioner alludes (Pet. 7-8), is no longer of any significance.

CONCLUSION

The ruling of the court below is in accord with the consistent judicial construction of the Trade-Mark Act of 1905. The petition for a writ of certiorari should, therefore, be denied.

Respectfully submitted.

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